

REMARKS

This Amendment, filed in reply to the Office Action dated November 2, 2005, is believed to be fully responsive to each point of rejection raised therein. Accordingly, favorable reconsideration on the merits is respectfully requested.

Claims 1-14 and 22 remain pending the application. Claims 15-21, 23 and 24 have been withdrawn from further consideration at this time. Claims 1, 6 and 7 have been deemed to be improper generic claims. Claims 1, 6 and 7 have been rejected under 35 U.S.C. § 112, second paragraph, as failing to set forth the subject matter which applicant(s) regard as their invention. Claims 1, 6 and 7 have been rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. Claims 1, 6 and 7 have been objected to under 35 C.F.R. § 1.75 as failing to conform to the invention as set forth in the remainder of the specification. Claims 1-5 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Jamzadeh et al. (U.S.P. 5,504,583). Claim 8 has been deemed allowable but objected to for depending on rejected base claims. Claims 9-14 depend upon claim 8, directly or indirectly and have also been deemed allowable but objected to.

Applicant respectfully submits the following comments in traversal of the objections and rejections of the Office Action.

With regard to the withdrawal of claims 23-24, these claims describes returning a forward end to include a path not containing the reading section. The claims read on a loop that does not include the reading section, such as the loop section (31) of Fig. 1. Therefore, contrary to the

Examiner's contention, the claims correspond to the elected species. The claims should be considered on the merits and any such rejection must be made on a non-final basis.

Claim 1 has been deemed generic to both Figs. 1 and 5 and remain generic because no amendments have been set forth in the prosecution of the case. The Examiner appears to agree that the claim can read on either Fig. 1 or Fig. 5. (Office Action, second full paragraph). Therefore, it is clear that the specification supports the claim as pending. The Examiner appears to contend that the alternative language in the claims renders the claims unsupported by Section 112, first and second paragraphs. However, it is clear that alternative claim language that reads on different embodiments of the invention are proper. *Ex parte Holt*, 19 USPQ2d 1211, 1214 (BPAI 1991); See also *Ex parte Ohshiro*, 14 USPQ2d 1750, 1752 (stating that an applicant in a mechanical case may be allowed claims which cover more than the specific embodiment shown, if the prior art permits). In this situation, the Examiner's statement that the claims are supported by Section 112 should make apparent that the claim is properly supported by the specification and disclosure. The presence of alternative language should not change that result, since it is the alternative language that contributes to the generic nature of claim 1 nor render claim 1 indefinite.

By explanation, Fig. 1 shows a return of the forward end to the exit side with transport in the reverse direction. Fig. 5 shows return of the forward end to entry side with transport in the same first direction. The alternative features are supported by the disclosure, and contrary to the Examiner's contention, U.S.P.T.O. precedent does not require the claims to be directed to a

single embodiment. Therefore, the objections and rejections of claims 1, and 6-7 should be withdrawn.

With regard to the prior art rejection over Jamzadeh, the Examiner maintains the same basis for rejection and offers rebuttals in reply to the prior submitted arguments. In particular, the Examiner again emphasizes that the depiction of single arrow Of Fig. 2 of Jamzadeh teaches the directional aspect of claim 1. This remains incorrect for all the reasons previously submitted and is also incorrect because of improper use of inherent disclosure. The possibility that the apparatus of Jamzadeh can operate in a certain fashion does not support a prior art rejection. In re Robertson, 49 USPQ2d 1949, 1951 (Fed. Cir. 1999). The prior submitted arguments presented several alternative operations which would indicate that Jamzadeh does not operate in manner as claimed. These alternatives include editing out of images which would preclude reading in the sequence as claimed. As a further alternative, the film can be placed with a trailing end on the return and the machine operated through the opposite direction.

The Examiner's suggested option of reversing a drive motor to simplify the control mechanism actually teaches away from the claim. The simple reversal of the drive mechanism would cause **returning of the trailing end**, otherwise additional turning mechanisms would be required. By contrast, claim 1 describes **returning the forward end** to the entry or exit side.

The burden remains on the Examiner to demonstrate a prima facie case, including inherent disclosure. In this situation, because of the multitude of options that do not render

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Applicant's claims unpatentable, the prior art rejection must be withdrawn. The Examiner has erred as a matter of law.

With regard to the statement for reasons for allowance, the Examiner refers to a loop. However, the feature of the loop is not recited in claim 8. The claims should be deemed allowable based on their respective recitations.

Applicant adds claim 25 to describe the direction of the driving in association with the exit or entry side return more particularly.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

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The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.


Respectfully submitted,

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